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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/911,024
Filing Date: July 24, 2001
Appellant(s): REUNING ET AL.

Mark Pohl
Reg. No, 35,325
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/3/2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1-66 are pending.

Claims 1-25; 33-58 and 66 stand rejected under 35 USC 103(a) as unpatentable over Hartman et al. (**US 2002/0111958 A**) in view of Mossberg (Mossberg, Walter, S, "Personal Technology: Threats to privacy on-line become more worrisome," Wall Street Journal, Oct. 24, 1996), further in view of Boguraev (US 5,799,268).

Claims 26-32 and 59-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. in view of Mossberg, and further in view of Peach et al. (US 5,321,604).

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is incorrect. A correct statement of the status of the claims is as follows:

Whether the OFFICE ACTION shows that claims 1-25; 33-58 and 66 are unpatentable over Hartman in view of Mossberg, and further in view of Boguraev?

Whether the OFFICE ACTION shows that claims 26-32 and 59-65 are unpatentable over Hartman et al. in view of Mossberg, and further in view of Peach?

(7) Grouping of Claims

Appellant's brief includes statements that the OFFICE ACTION raises three

distinct obviousness rejections against three distinct groups of claims.

However, the OFFICE ACTION actually defines two separate rejection groupings, made up of the following:

Group 1. Claims 1-25, 33-58 and 66 stand rejected under 35 USC 103(a) as unpatentable over Hartman in view of Mossberg, further in view of Boguraev.

Group 2. Claims 26-32 and 59-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. in view of Mossberg, and further in view of Peach.

Thus, the rejection of Group1 (based on independent Claim 1) and Group 2 (based on independent Claim 26) will stand or fall together, because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

US 2002/0111958 A	HARTMAN et al.	8-2002
US 5,799,268	BOGURAEV	5-1998
US 5,321,604	PEACH et al.	5-1994
Wall Street Journal, Oct. 24, 1996	MOSSBERG	10-1996

(10) Grounds of Rejection

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

   a. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. **Claims 1-11, 13-25, 33-44, 46-58, and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US 2002/0111958 A) in view of Mossberg (Mossberg, Walter, S, "Personal Technology: Threats to privacy on-line become more worrisome," Wall Street Journal, Oct. 24, 1996), further in view of Boguraev (US 5,799,268).**

3. As per independent Claims 1 and 34, Hartman discloses a method of collecting professional profile data, Identifying contact information data, and Storing said Professional Profile and said contact information data into a data structure (Abstract, C5 L25-65).

4. Hartman fails to disclose a method for harvesting professional profiles, the method comprising: Searching the Internet, Identifying web pages and Internet postings containing profile data.

5. Mossberg discloses a method for harvesting professional profiles, the method comprising: Searching the Internet, Identifying web pages and Internet postings containing profile data (Para 8-9).
6. Neither Hartman nor Mossberg disclose identifying in said professional profile text strings constituting contact information data.
7. Boguraev teaches identifying information data in document text strings (Abstract, C1 L9-10, C57 L11-41, C65 L46-67, C66 L1-5).
8. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a method for harvesting professional profiles, the method comprising: Searching the Internet, Identifying web pages and Internet postings containing profile data, and identifying in said professional profile text strings constituting contact information data as disclosed by Boguraev in the system disclosed by Mossberg, in the system disclosed by Hartman, for the advantage of providing a method of collecting professional profile data, with the ability to increase effectiveness and customer reach, by obtaining profile data directly from the internet through, the use of data harvesting capabilities.
9. As per Claims 2 and 35, Hartman, *Mossberg*, and Boguraev disclose wherein said contact information comprises an extractable e-mail address.
10. As per independent Claims 3 and 36, Hartman, Mossberg, and Boguraev disclose a method for normalizing data from a document containing professional profile data, the method comprising: Obtaining said document, Reading said document, Identifying in said document text strings constituting contact information data, and

Storing said professional profile data and said contact information data into a data structure (see rejection of independent Claims 1 and 34).

11. As per Claims 4 and 37, Hartman, *Mossberg*, and Boguraev disclose wherein said contact information comprises an extractable e-mail address.

12. As per Claims 5 and 38, *Hartman*, Mossberg, and Boguraev disclose reading documents and combining to create a professional profile, Identifying in said professional profile text strings constituting contact information data, and copying said professional profile and contact information data into a data structure.

13. As per Claims 6 and 39, *Hartman*, Mossberg, and Boguraev disclose sorting the data in said data structure to identify profiles meeting a specified parameter, and merging said contact information with a pre-defined document template to create a personalized document.

14. As per Claims 7 and 40, Hartman, *Mossberg*, and Boguraev disclose wherein said professional profile is obtained by harvesting from the Internet (Mossberg: Para 8-9).

15. As per Claims 8, 16, 23, 41, 49, and 56, *Hartman*, Mossberg, and Boguraev disclose wherein said professional profile is obtained from a third party source.

16. As per Claims 9 and 42, *Hartman*, Mossberg, and Boguraev disclose wherein said professional profile is obtained via a professional profile collection program on a website.

17. As per Claims 10, 18, 25, 43, 51, and 58, *Hartman*, Mossberg, and Boguraev disclose wherein said professional profile is obtained as a response to help wanted advertising.

18. As per Claims 11 and 44, *Hartman*, Mossberg, and Boguraev disclose wherein said pre-defined document template can incorporate an electronic object.

19. As per Claims 13-14, **19**, 46-47, and **52**, *Hartman*, Mossberg, and Boguraev disclose a method for creating a list of sales or advertising prospects, the method comprising: Obtaining professional profiles, Storing said professional profiles in a data structure, and Sorting to identify a subset of professional profiles stored in said data structure (see rejection of independent Claims 1 and 34).

20. As per Claims 15, 22, 48, and 55, Hartman, *Mossberg*, and Boguraev disclose wherein said professional profile is obtained by harvesting from the Internet.

21. As per Claims 17, 24, 50, and 57, *Hartman*, Mossberg, and Boguraev disclose wherein said professional profile is obtained via a professional profile collection program on a website.

22. As per Claims 20 and 53, Hartman, Mossberg, and *Boguraev* disclose exporting contact information data from said subset of professional profiles to create a list.

23. As per Claims 21 and 54, Hartman, Mossberg, and *Boguraev* disclose wherein said list may take the form of: A printed list, A digital file, A delimited format file, A format which causes a message to be delivered to each professional profile's contact, or A merged document.

24. As per independent Claims 33 and 66, Hartman, Mossberg, and Boguraev disclose a method of selecting advertisement and notice delivery addresses, the method comprising: Searching a data structure containing professional profiles, Identifying a subset of professional profiles, Identifying in said professional profiles text strings

constituting contact information data, and Exporting said contact information data (see rejection of independent Claims 1 and 34).

25. **Claims 12 and 45 are rejected under 35 U.S.C. 103 as being unpatentable over Hartman, Mossberg, and Boguraev.**

26. As per Claims 12 and 45, Hartman, Mossberg, and Boguraev do not expressly show wherein said pre-defined document template includes an advertising message.

27. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The pre-defined document template would be created regardless of what was included in the template. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

28. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an advertising message in the pre-defined document template, because such a message does not functionally relate to the steps in the method claimed and because the subjective interpretation of the message does not patentably distinguish the claimed invention.

29. **Claims 26-32 and 59-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. in view of Mossberg, and further in view of Peach et al. (US 5,321,604).**

30. As per independent Claims 26 and 59 as understood by the examiner, Hartman and Mossberg disclose a method comprising: sorting professional profiles in a data

structure, and merging contact information from said professional profiles into said deliverable medium (see rejection of independent Claims 1 and 34).

31. Hartman and Mossberg fail to disclose selecting one or more items from a collection of computer stored images, computer stored text objects, computer stored audio objects, computer stored video objects, or other computer stored objects, Combining said selections into a deliverable medium.

32. Peach teaches selecting one or more items from a collection of computer stored images, computer stored text objects, computer stored audio objects, computer stored video objects, or other computer stored objects, Combining said selections into a deliverable medium (Abstract, C2 L1-6, C2 L61-69, C3 L1-40, C13 L49-68, C14 L1-34).

33. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included selecting one or more items from a collection of computer stored images, computer stored text objects, computer stored audio objects, computer stored video objects, or other computer stored objects, and combining said selections into a deliverable medium, as disclosed by Peach in the system disclosed by Mossberg, in the system disclosed by Hartman, for the advantage of providing a method of collecting professional profile data with internet data harvesting capabilities, and direct mail advertising capabilities.

34. As per Claims 27 and 60, Hartman, Mossberg, and *Peach* disclose delivering said deliverable medium to prospects.

35. As per Claims 28 and 61, Hartman, Mossberg, and *Peach* disclose printing said deliverable medium as a post card or letter.

36. As per Claims 29 and 62, Hartman, *Mossberg*, and Peach disclose wherein said professional profile is obtained by harvesting from the Internet.

37. As per Claims 30 and 63, *Hartman*, Mossberg, and Peach disclose wherein said professional profile is obtained from a third party source (Hartman: Para 0003 and 0011).

38. As per Claims 31 and 64, *Hartman*, Mossberg, and Peach disclose wherein said professional profile is obtained via a professional profile collection program on a website.

39. As per Claims 32 and 65, *Hartman*, Mossberg, and Peach disclose wherein said professional profile is obtained as a response to help wanted advertising.

(11) Response to Arguments

40. Appellant has claimed priority (September 10, 1996 – Declaration) to a parent application (08/984650, now US Patent 6,381,592) with 2 out of 5 claim limitations in the independent claims identical to the current application independent claims.

41. However, affidavits or declarations, such as those submitted under 37 CFR 1.131 and 37 CFR 1.132, filed during the prosecution of the parent application do not automatically become a part of this application. Where it is desired to rely on an earlier filed affidavit or declaration, the appellant should make the remarks of record

in the later application and include a copy of the original affidavit or declaration filed in the parent application.

42. Furthermore, the appellant is correct when stating, "antedating possession of only two claim limitations does not antedate a reference against the entire (five-limitation) claim. Rather, an application ***must*** show antedating possession of the claim as a whole."

43. In response to appellant's arguments against the references (Hartman) individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations (Hartman in view of Mossberg, further in view of Boguraev) of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

44. The appellant's arguments regarding the use of Hartman during prosecution of the parent application are considered mute – as the prosecution is completely separate for each specific application.

45. In response to appellant's argument that Boguraev is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Boguraev, Hartman and Mossberg all disclose systems/methods for obtaining and manipulating data.

46. In response to appellant's argument that there is no suggestion to combine the references (Hartman with Boguraev or Mossberg), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Both Hartman and Mossberg disclose a system used to obtain user profile data and provide the obtained data to system users (marketers/employers) (Hartman: abstract, C3 L50-57, C13 L41-49), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings as disclosed by Mossberg, in the system disclosed by Hartman, for the advantage of providing a method of collecting professional profile data, with the ability to increase effectiveness and customer reach, by obtaining profile data directly from the internet through, the use of data harvesting capabilities.

47. In response to appellant's argument that there is no suggestion to combine the references (Boguraev with Hartman or Mossberg), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071,

5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Both Boguraev and Hartman disclose a system related to natural language processing of textual information (Boguraev: C1 L9-10). The applicant makes the argument that the system Boguraev discloses requires "well defined genre of text," and Hartman discloses obtaining the profile information in a form outline (Hartman: C5 L25-65), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings as disclosed by Boguraev, in the system disclosed by Hartman, for the advantage of providing a method of collecting professional profile data, with the ability to increase effectiveness and efficiency of the system by, by automatically pulling contact information from the profile data to provide to system users.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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